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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOK ET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/868,880 | 01/18/2002 | Colin Beveridge | DEXNON/110/PC/US | 2458 |

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EXAMINER

PIERCE, JEREMY R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,880

Applicant(s)

BEVERIDGE ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, 17, 18, and 20, drawn to a nonwoven composite.

Group II, claim(s) 15, 16, and 19, drawn to a process for producing a nonwoven composite.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of a nonwoven composite being treated with the claimed agents in a level of 3% is .

3. Applicant's election with traverse of Group I, claims 1-14, 17, 18, and 20 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that it would be a serious burden to examine all claims as originally filed. This is not found persuasive because the product claims are in class 442, whereas the claims directed to the process of making the product are in class 28. Additionally, the restriction requirement set forth in the last Office Action was not done according to the Lack of Unity rules of a 371 Application. The new restriction requirement using the lack of unity standard is set forth above. During a telephone conversation with James Piotrowski on November 14, 2003, confirmation of the election to Group I under lack of unity rules was

made. Claims 15, 16, and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 20 recites "the nonwoven composite has a dry grain value within 25% of a dry grain value of the first layer by itself." The specification does not enable a person skilled in the art to measure a dry grain value. It is not clear what a dry grain value is.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "the nonwoven composite has a dry grain value within 25% of a dry grain value of the first layer by itself." What does it mean to have a dry grain value? How does one measure dry grain value? What is dry gain value? The specification

does not disclose what this measurement is, so the Examiner can only assume that when the product limitations of the claims are met, this property of dry gain value will also be met.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lefkowitz et al. (U.S. Patent No. 4,070,519).

Lefkowitz et al. disclose a filter media comprising a surface layer of glass fibers and an underlayer of mineral fibers (column 2, lines 32-36). The layers are needled together (column 2, lines 50-52). Afterward, the fabric is treated with various silicone derivative resins in an amount of 5 to 40% by weight of the fabric (column 6, lines 1-5). With regard to claim 3, the nonwoven glass layer is formed by carding and is later subjected to needling (column 5, line 21).

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lefkowitz et al.

Although Lefkowitz does not explicitly teach the limitation of dry grain value, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. nonwoven fibrous layers treated with a silicone) and in the similar production steps (i.e. entangling the layers together) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the process disclosed by Lefkowitz would obviously have provided the claimed property. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Claim Rejections - 35 USC § 103

12. Claims 1, 2, 4-14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Homonoff et al. (EP 557,678) in view of Nohr et al. (U.S. Patent No. 4,976,788).

Homonoff et al. disclose a composite spunbonded fabric that is useful in molding substrates (page 2, line 7). The composite fabric comprises a nonwoven spunbonded base layer (page 3, lines 39-40) and a tissue web cover layer (page 4, lines 26-28). The multilayer structure is subjected to hydroentanglement to bond layers together (page 3, line 26). Homonoff et al. do not disclose adding a treatment composition

comprising silicones, silicone derivatives, or quaternary ammonium compounds. Nohr et al. disclose the inclusion of polysiloxane in a nonwoven fabric used in molding substrates in an amount of 0.1 to 10% by weight can improve the properties of the fabric (column 4, lines 1-10). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include polysiloxane treating agent into the fabric of Homonoff et al. in order to give the fabric self-lubricating properties and increase resistance to wear, as taught by Nohr et al. With regard to claim 2, Homonoff et al. disclose the base layer can be polyamide, polyester, or polyolefin (page 3, line 50). With regard to claim 5, Homonoff et al. disclose the spunbonded fabric may weigh between 15 and 90 gsm (page 3, line 41). With regard to claims 6-8, the cover layer may be made from sisal, jute, or hemp (page 4, line 47). With regard to claim 9, the cover layer can be wet laid (page 4, line 38). With regard to claim 10, the cover layer may weigh between 10 and 60 gsm (page 5, lines 1-2). With regard to claim 20, although neither Homonoff et al. nor Nohr et al. do not explicitly teach the limitation of dry grain value, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. nonwoven fibrous layers treated with a silicone) and in the similar production steps (i.e. entangling the layers together) used to produce the fabric. The burden is upon the Applicant to prove otherwise. In the alternative, the process disclosed by Homonoff et al would obviously have provided the claimed property.

13. Claims 17 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Homonoff et al. in view of Nohr et al. as set forth above and further in view of Spengler et al. (U.S. Patent No. 5,709,925).

Homonoff et al. disclose using the fabric in a molded substrate, but do not disclose additional layers that would be used in that purpose. Spengler et al. disclose using a decorative layer and foam layer in addition to the fibrous layer when making a molded substrate for a door panel (column 3, lines 5-59). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide an additional form layer and a decorative layer to the fibrous layer of Homonoff et al. in order to provide sufficient padding and good aesthetics when applying the substrate into a molded part, as taught by Spengler et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JRP
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ELIZABETH M. COLE
PRIMARY EXAMINER